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10/563,489	01/03/2006	Thomas Lederer	2003P07074WOUS	8264
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TIV, BACKHEAN				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

## Application No.

10/563,489

## Applicant(s)

LEDERER ET AL.

## Examiner

BACKHEAN TIV

## Art Unit

2451

**Period for Reply**  
-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 28 October 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 12-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-942)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

***Detailed Action***

Claims 12-31 are pending in this application. Claims 1-11 have been cancelled. This is a response to the Amendments/Remarks filed on 10/28/10. This action is made **FINAL**.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 12-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Microsoft Outlook 2002 released date of 5/31/01 in view of Windows XP released date 10/01 (see screen shot of Outlook 2002 installed on Windows XP OS system) in view of US Publication 2004/0158607 issued to Coppinger et al. (Coppinger).

As per claim 12, 18, 31 Outlook 2002 teaches a device for user-based processing of at least one electronic message (Outlook 2002 installed on computer), the device comprising: an e-mail client configured to receive at least one electronic message having a file attachment (Fig. 2).

Windows XP teaches a user file system configured to store the file attachment (Fig. 3); an attachment insertion unit configured to insert the replaced file attachment in a selected memory location in a file system (Fig. 4); a message link insertion unit configured to insert a message link in the selected memory location, the message link referring to the electronic message (Fig. 7, 11; user can create a shortcut the message and/or save electronic message); and a control unit configured to control

the e-mail client, the attachment substitution unit, the message link insertion unit and the attachment insertion unit(Windows XP installed on a computer with a processor, memory, etc.).

Therefore it would have been obvious to one ordinary skill in the art at the time of the invention to modify the teachings of Outlook 2002 to include creating shortcuts to an email message and saving the shortcut as taught by Microsoft XP in order to save emails and/or create shortcuts to email for quick access.

One ordinary skill in the art would have been motivated to combine the teachings of Outlook 2002 and Microsoft XP in order to save emails and/or create shortcuts to email for quick access.

Window Outlook 2002 and XP does not explicitly teach an attachment substitution unit configured to replace a file attachment of a received electronic message with a memory location link and link after user input is received that requires the file attachment to be saved and linked.

Coppinger explicitly teach an attachment substitution unit configured to replace a file attachment of a received electronic message with a memory location link and link after user input is received that requires the file attachment to be saved and linked. (Fig.1, 2; inherently the file attachment is saved before linking).

Therefore it would have been obvious to one ordinary skill in the art at the time of the invention to modify the teachings of Microsoft Outlook 2002 and XP to include an attachment substitution unit configured to replace a file attachment of a received

electronic message with a memory location link as taught by Coppinger in order to link an attachment and a memory location link to an email(Coppinger, para.0010).

One ordinary skill in the art would have been motivated to combine the teachings of Outlook 2002, Windows XP, and Coppinger in order to link an attachment and a memory location link to an email(Coppinger, para.0010).

Outlook 2002 in view of Windows XP in view of Coppinger does not explicitly teach the use of a save as and link command.

However taken into consideration, The Supreme Court in KSR International Co. v. Teleflex Inc., 550 U.S. \_\_\_, \_\_\_, 82 USPQ2d 1385, 1395-97 (2007) identified a number of rationales to support a conclusion of obviousness which are consistent with the proper "functional approach" to the determination of obviousness as laid down in Graham. The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in KSR noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. EXEMPLARY RATIONALES Exemplary rationales that may support a conclusion of obviousness include: (A) Combining prior art elements according to known methods to yield predictable results.

Outlook 2002 in view of Windows XP in view of Coppinger teaches the link and save as command as two separate commands(Windows XP, Figs.1-12, Coppinger, Figs.1,2).

Therefore it would have been obvious to one ordinary skill in the art at the time of the invention to modify the teachings of Outlook 2002 in view of Windows XP in view of

Coppinger of having two separate commands for linking and saving to combine both of these command into one command, by combining the prior art elements would yield a predictable result which is when a user uses the save and link command, a file would be saved and linked at the same time, which save a user's time.

One ordinary skill in the art would have been motivated to combine the teachings of Outlook 2002, Windows XP, and Coppinger in order to save's a user's time by executing only one command to save and link a file.

As per claim 13, the method according to claim 12 wherein the user-selected memory location is a file and the second link is created and saved (Fig.10; shortcut is saved in the same folder as the attachment), such that the second link is displayed in the file, the second link configured to display the electronic message after the second link is actuated (Fig.11,12, user opens the shortcut and the email is actuated or displayed).

As per claim 14, the method according to claim 13, wherein at least one file attachment has a file name that is changed when the at least one file attachment is saved(Fig.3,4,8; inherent, changing file name, operation in Microsoft XP).

As per claim 15, the method according to claim 14, wherein the second link is comprised of a name that is comprised of the changed file name(Fig.3,4,8; inherent operation in Microsoft XP).

As per claim 16, the method according to claim 12 wherein the electronic message is an e-mail of an SMTP e-mail client(Fig.1, Simple Mail Transport Protocol is

commonly used in Outlook 2002 also supported by applicant's specification, page 1, line 21).

As per claim 17, the method according to claim 12, wherein the at least one file attachment is saved according to a defined role and/or in a set file structure(Fig.3, attachment can be saved in any folders and/or setting a specific folder for saving).

As per claim 19, the device according to claim 18 wherein the selected memory location is a file in the file system and the message link is created and saved such that the message link is displayed in that file, the same file as the file attachment, the message link configured to display the electronic message after the message link is actuated(Fig.10; shortcut is saved in the same folder as the attachment, Fig.11,12, user opens the shortcut and the email is actuated or displayed).

As per claim 20, the device according to claim 19, wherein the message link is comprised of a file name of the inserted file attachment(Fig.9)

As per claim 21, the device according to claim 18, wherein the attachment insertion unit is configured to automatically file the replaced file attachment using a modified file name(Fig.3,4,8; inherent operation, changing file names, in Microsoft XP, Coppinger, Fig.1,2).

As per claim 22, the device according to claim 21, wherein the attachment insertion unit files the replaced file attachment according to a user-defined user define rule and/or a user-define file structure(Microsoft screenshot, Fig.3, Coppinger, Fig.2; para.0019). Motivation to combine set forth in claim 18.

As per claim 23, the method of claim 12 further comprising replacing the at least one file attachment with at least one attachment link in the electronic message(Coppinger, Figs.1,2). Motivation to combine set forth in claim 18.

As per claim 24, the method of claim 12 wherein the user-selected memory location is a hard disk of a telecommunications terminal or a memory accessible via a network(Fig.3, user can save on the network).

As per claim 25, the method of claim 12 wherein the link is a backlink(Fig.10, shortcut, as in Fig.3 of specification).

As per claim 26, the method of claim 12 wherein the user-selected memory location is a file of a file system, the file system stored on and/or maintained by an electronic device selected from the group consisting of computers, telecommunications terminals and networks(Coppinger, para.0015). Motivation to combine set forth in claim 18.

As per claim 27, the device of claim 18 wherein the message link is a backlink(Fig.10, shortcut, as in Fig.3 of specification).

As per claim 28, the device of claim 18 wherein the user-selected memory location is a file of a file system, the file system stored on and/or maintained by an electronic device selected from the group consisting of computers, telecommunications terminals and networks(Coppinger, para.0015). Motivation to combine set forth in claim 18.

As per claim 29, the device of claim 18 wherein the selected memory location is a file of a file system and the message link insertion unit is configured to insert a



message link in the file-such that the message link is displayed in the same file along with the file attachment, the message link configured to display the electronic message after the message link is actuated(Fig.10; shortcut is saved in the same folder as the attachment, Fig.11,12, user opens the shortcut and the email is actuated or displayed).

As per claim 30, The device of claim 18 wherein the message link insertion unit is comprised of a backlink generation apparatus (Fig.10, shortcut, as in Fig.3 of specification).

### ***Response to Arguments***

The applicant pointed out support for the amendments therefore the 112 1<sup>st</sup> rejection is withdrawn.

Applicant's arguments filed 10/28/10 have been fully considered but they are not persuasive.

In applicant argues in substance,

- a) the prior art does not teach the save as and link command,
- b) XP and Outlook utilize the claimed method,

***In reply to a);*** The limitation of save as and link command is addressed using KSR rejection, see above for analysis.

***In reply to b);*** Pertaining to whether the someone actually used the method of XP and Outlook, the applicant in essence is arguing non-statutory subject matter, e.g. a person doing the steps of XP and Outlook as claimed. XP and Outlook teaches the functionality of the claimed language, and it is not necessary for the examiner to provide evidence of whether a person uses the claimed method of XP and Outlook as this is

non-statutory subject matter, therefore showing that XP and Outlook teaches the claimed method is sufficient .

### ***Conclusion***

**Examiner's Note:** Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in its entirety as potentially teaching of all or part of the claimed invention.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Backhean Tiv whose telephone number is (571) 272-5654. The examiner can normally be reached on M-F 6:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (571) 272-3964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Backhean Tiv/  
Examiner, Art Unit 2451

/John Follansbee/  
Supervisory Patent Examiner, Art Unit 2451